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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|------------------------|------------------|
| 10/705,256 | 11/10/2003 | Ivano Vagnoli | 141483.00004-P1244US00 | 3201 |

25207 7590 02/27/2007

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| EXAMINER |
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WATKINS III, WILLIAM P

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| ART UNIT | PAPER NUMBER |
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1772

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 02/27/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/705,256

Applicant(s)

VAGNOLI, IVANO

Examiner

William P. Watkins III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-12 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6 and 8-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this

Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 6, 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liardet (U.S. 4,864,790) in view of Hirsch (U.S. 4,849,145) and Zegler et al. (U.S. 5,567,497) further in view of Most (U.S. 2,161,549).

Liardet teaches a floor tile or roll with a leather surface and a backing layer joined by adhesive (abstract, col. 9, lines 30-20). Zegler et al. teaches joining a top surface covering that has a layer which will fuse with thermoplastic to a thermoplastic base which has channels (abstract). Hirsch teaches joining thermoplastic to a leather layer by injection of the thermoplastic into openings in the leather layer and around edges of the leather layer (abstract, Figure 5, col. 1, lines 45-60). Most teaches the flow of plastic into holes in the

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interior of an outer layer in order to better bind the plastic to the outer layer and provide decorative effects (col. 2, lines 25-55).

The instant invention claims a leather floor tile with a thermoplastic backing that has resin that extends through holes in the leather layer that are located away from the perimeter of the leather layer. It would have been obvious to join a thermoplastic as the base layer of Liardet to prevent slipping because of the teachings of Zegler et al. (U.S. 5,567,497). It further would have been obvious to have joined the leather layer and bottom resin layer by injecting resin into holes of the leather layer instead of using adhesive because of the teachings of Hirsch. It still further would have been obvious to locate the joining holes away from the perimeter of the upper leather layer in order to promote good joining and different decorative effects.

3. Applicant's arguments filed 15 December 2006 have been fully considered but they are not persuasive.

Applicant argues that there is no motivation to combine the thermoplastic lower level of Zegler et al. with the tile of Liardet. The examiner disagrees. In addition to rigid tiles

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Liardet also contemplates use of leather surfaces on more flexible substrates (col. 9, lines 20-25). Zegler et al. teaches use of a thermoplastic backing that prevents slip when a flexible floor covering is placed over an existing floor. Thus both references are in the same art area and there is motivation to prevent slip in the covering of Liardet when it does not have a rigid backing layer. Applicant argues one of ordinary skill in the art would not look to Hirsch, who is directed to watch bands to solve a problem in the floor tile art. The examiner disagrees. Both Hirsch and Liardet in view of Zegler et al. have a common problem of securing leather to resin substrates. Thus Hirsch is analogous art and would be looked to by one working in the floor covering art. Applicant also argues that Most is not analogous art and that there is no motivation to combine it with the combination of the references. Liardet teaches decorating floor tile with patterns, textures and colors (col. 9, lines 23-25). Most is also directed to this common problem of forming decorations on substrates and thus is analogous art. As the combination of Liardet in view of Zegler and Hirsch has resin protruding up from a lower surface through apertures and the common problem of forming decorative surfaces,

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there is motivation to use the method of decorating taught by Most.

4. This application contains claims 1-5 drawn to an invention nonelected with traverse in the amendment filed 1 September 2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is 571-272-1503. The examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



WW/ww

February 18, 2007

**WILLIAM P. WATKINS III
PRIMARY EXAMINER**